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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/209,454	12/11/1998	HIDENARI TANAKA	88125/ASAHIN	6958
23548	7590	10/21/2004	EXAMINER	
LEYDIG VOIT & MAYER, LTD 700 THIRTEENTH ST. NW SUITE 300 WASHINGTON, DC 20005-3960			LASTRA, DANIEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/209,454

Applicant(s)

TANAKA ET AL.

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/16/04.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 17-22 have been examined. Application 09/209,454 (METHOD OF SELLING CONTACT LENS) has a filing date 12/11/1998 and foreign priority date 12/12/1997.

Response to Amendment

2. In response to Office Action dated 04/21/04, the Applicant amended claim 17. Applicant's ~~14~~ amendment overcame the 101 and 112 rejections.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauly et al (U.S. 4,958,280) in view of Fay (U.S. 5,983,201) and further in view of Eberhardt (U.S. 5,659,741).

As per claim 17, Pauly et al teach:

A method of selling prescription contact lenses said method comprise:

transferring contact lens customer identification, address, and diagnostic data pertaining to a respective contact lens customer from a plurality of second group information processing apparatus *located at respective facilities of contact lens prescribers, the plurality of second group information processing apparatus being*

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connected through a communication network to a first group information processing apparatus located at a facility of a contact lens seller, to the first group information processing apparatus through the communication network (see column 2, line 35 – column 3, line 5; column 3, line 36 – column 4, line 38; column 5, lines 4-18; column 6, lines 11-33);

assigning a registration number to the customer and storing the registration number assigned in relationship with the customer identification and diagnostic data transferred to the contact lens seller (see column 6, lines 39-45);

Fay teaches:

providing the registration number assigned and selling agent data for a selling agent closest in geographical relation to the customer based on the customer address data, from the contact lens provider to the customer, through the communication network (see column 5, line 55 – column 6, line 54);

delivering a contact lens from the selling agent to the customer (see column 6, lines 35-54);

transferring delivery data from the selling agent to the contact lens provider through the communication network (see column 6, lines 48-54).

Although the Fay system relates to the selection of eyeglass frames and not to contact lenses, it can be used to view, select, and purchase other related products (see column 9, lines 4-8). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly system would deliver the purchase product, in this case contact lenses, to a selling agent that would take care

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of delivering the product to the customer, as taught by Fay. Therefore, if the selling agent is an optical retail store (see Fay column 6, lines 35-40), the customer would go to that store to pick up the product and this way he/she would save the shipping and handling charges.

Pauly fails to teach:

writing, through both the first group information processing apparatus and the plurality of second group information processing apparatus, on respective portable recording media for each contact lens customer, data, including the corresponding registration number, and issuing the corresponding portable recording medium to the respective customer, so the contact lens customer can select any contact lens prescriber, and change between any contact lens prescriber, having access to one of the second group information processing apparatus and the communication network without changing the contact lens seller; determining an exchange time for exchanging the contact lens, based upon date of issuance of the contact lens and characteristics of the contact lens, by the first group information processing apparatus of the contact lens seller, using data recorded on the portable recording medium of the corresponding contact lens customer to whom a contact lens has been issued by the contact lens seller through the selling agent; and notifying a contact lens customer to whom a contact lens was issued of the exchange time. However, Eberhardt teaches a portable recording media that stores patient's medical data, such as prescription information, expiration date, date of purchase, refills and prescription's date of completion (see column 3, lines 39-67; column 4, lines 50-53; column 14, lines 13-36). Therefore, it

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would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly would use a portable recording media, as taught by Eberhardt, to store contact lenses' prescription data. A contact lens customer would present the portable recording media to any contact lens prescriber, that would read the portable recording media and obtain an accurate information about the customer history of lens usage, even when the customer is very ill, unconscious, unable to speak or ignorant about his or her medical history.

As per claim 19, Pauly does not expressly teach:

The method of Claim 17, including offering new contact lenses to the *contact lens* customer in exchange for old contact lenses at irregular times, upon any of loss of transparency of the contact lenses, breakage of the contact lenses, and scratching or soiling of the contact lenses, and a monthly payment by the *contact lens* customer. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that even though a patient would have a set up wear schedule where it would receive new contact lenses according to a set up time, as taught by Pauly (see column 7, lines 10-21), if for whatever reason the patient breaks a contact lens or scratches it, even though he/she is not scheduled to receive new contact lenses, he/she may choose to get them out of schedule because out of convenience, his or her preference and/or the better quality of vision provided by the contacts.

As per claim 21, Pauly teaches:

The method of claim 19, including contracting for a one year term with the respective *contact lens* customer for supplying long-term-use contact lenses in

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exchange for the old contact lenses and the monthly payment (see column 7, lines 9-48).

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pauly et al (U.S. 4,958,280) in view of Fay (U.S. 5,983,201) and further in view of Eberhardt (U.S. 5,659,741) and Dawson, Jr. et al (U.S. 5,623,242).

As per claim 18, Pauly teaches:

The method of Claim 17, but does not expressly teach including delivering notification of an approaching deadline to replace the contact lens from the contact lens *seller* to the *contact lens* customer through the communication network. Dawson teaches a system where patient prescription information is entered and stored in a database and a remainder signal is generated and transmitted to a patient in response to the stored information (see column 2, lines 10-25). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly would store a patient's prescription wear schedule in a database and would send a remainder message to the patient that would indicate that the time to replace the contact lenses is due. This feature would help patients have a new supply of contact lenses on hand.

Claims 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauly et al (U.S. 4,958,280) in view of Fay (U.S. 5,983,201) and further in view of the article Cashing in on quicker delivery times and Eberhardt (U.S. 5,659,741).

As per claim 20, Pauly fails to teach the method of Claim 17, including periodically offering for sale contact lens care articles by the contact lens *seller* to the

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customer through the communication network. However, the article Cashing in on quicker delivery times teaches about a system where the contact lens provider offers to its customers 99.99 percent on-time delivery of its product when using the contact lens provider ordering network and offers customers the option of ordering product direct from local distributors (see paragraphs 3-7). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly's customers would use the contact lens provider network system to order contact lens products and would receive products updates periodically, as taught by the article. This feature would give customers a reliable venue to obtain the products related to their contact lens care.

As per claim 22, Pauly fails to teach:

The method of claim 20, including periodically offering for sale the contact lens care articles based upon a consumption period of the contact lens care articles and date of most recent sale of the contact lens care articles to the respective contact lens customer transmitted from the first group information processing apparatus. Pauly teaches a system that changes the wear schedule and shipment of the contact lenses deliver to customers (see column 7, lines 9-11). And as explained in claim 20, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly's customers would use the contact lens provider network system to order contact lens products and would be able to change the wear schedule and shipment schedule, as taught by Pauly. This feature would give customers a reliable venue to obtain the products related to their contact lens care.

Response to Arguments

4. Applicant's arguments filed 07/16/04 have been fully considered but they are not persuasive. Applicant argues that an important feature in Pauly is an avoidance of disruption of patient-physician relationship and that the object of the invention is directly opposite that objective. The Applicant also argues that by supplying the portable recording medium, the contact lens customer can change prescribers easily, while maintaining a relationship with a nearby contact lens dispenser. The Examiner answers that Pauly would use a portable recording media, as taught by Eberhardt, to store contact lenses' prescription data. A contact lens customer would present the portable recording media to any contact lens prescriber, that would read the portable recording media to obtain an accurate information about the customer history of lens usage, even when the customer is very ill, unconscious, unable to speak or ignorant about his or her medical history. Claim 17 recites that the customer has the option to select any contact lens prescriber without changing the contact lens seller. Pauly and Eberhardt also give a customer the option to select any contact lens prescriber without changing the contact lens seller. Also, the Applicant is arguing about feature that are not in the claims when he argues that the object of his invention is directly opposite to an avoidance of disruption of patient-physician relationship. Nowhere in claim 17 or in the specification is mentioned that the purpose of the invention is to disrupt the patient-physician relationship.

The Applicant argues that since the use of contact lenses does not modify a person's appearance, there would be no reason to consult images with regard to

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different contact lenses to determine which lenses to select, as taught by Fay. Therefore, the Applicant argues that there is no teaching in Fay that would recommend it to one of skill in the art for modifying what is described in Pauly.

The Examiner answers that the prior art Fay was brought to teach the features of: "providing the registration number assigned and selling agent data for a selling agent closest in geographical relation to the customer based on the customer address data, from the contact lens provider to the customer, through the communication network (see column 5, line 55 – column 6, line 54); delivering a contact lens from the selling agent to the customer (see column 6, lines 35-54) and transferring delivery data from the selling agent to the contact lens provider through the communication network (see column 6, lines 48-54)". Although the Fay system relates to the selection of eyeglass frames and not to contact lenses, it can be used to view, select, and purchase other related products (see column 9, lines 4-8). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Pauly system would deliver the purchase product, in this case contact lenses, to a selling agent that would take care of delivering the product to the customer, as taught by Fay. Therefore, if the selling agent is an optical retail store (see Fay column 6, lines 35-40), the customer would go to that store to pick up the product and this way he/she would save the shipping and handling charges. The Fay reference teaches the selection of a customer to deliver a product near the customer geographic location. The fact that the Fay reference sells items related to personal appearance, does not get away from the

fact that the customer can select the product and be delivered to the nearest customers geographic location.

The Applicant further argues that none of the three references describes a method in which a person obtaining a product, such as a contact lens, that requires prescription by a professional, can easily move from professional to professional while maintaining a consistent relationship with a dispenser of the product through the use of a portable recording medium. The Examiner answers that the Applicant is arguing about features that are not in the claims. Claim 17 recites *"so the contact lens customer can select any contact lens prescriber, and change between any contact lens prescriber, having access to one of the second group information processing apparatus and the communication network without changing the contact lens seller"*. The claims never mentioned the limitation that is needed to maintain a consistent relationship with a dispenser of the product, the claim recites that a customer has the option to select any contact lens prescriber without changing the contact lens seller. Also the specification does not mention the limitation that the purpose of the invention is to maintain a consistent relationship between a dispenser and a customer. The Applicant is arguing about features that are not sustained by the Applicant's claims and specification.

The Applicant argues that the portable medical history record described by Eberhardt is only described with respect to physicians and like medical practitioners. The Applicant argues that while a user of the card might be able to move from physician to physician, amongst the physicians participating in the system, there is no description in Eberhardt of using the card to interact with sellers of goods, such as pharmacies.

The Examiner answers that the portable card in Eberhardt teaches "the patient may be prescribed pharmaceutical and/or take over the counter medications or even use illicit drugs. This information is recorded in the drug or prescription segment of the SD's memory. The program provides means whereby the drug segment of the SD card is transmitted, via computer modem, to a CDF at no charge via a 800 telephone number or over a computer communication network...The CDF is thereby able to compile vast amounts of data daily about specifics drugs and to report the same to the pharmaceutical companies". Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Eberhardt card would be used by pharmacies to read the users prescriptions.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

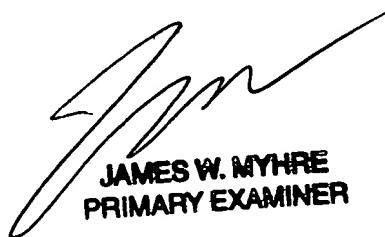
Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
October 7, 2004


JAMES W. MYHRE
PRIMARY EXAMINER